



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,423	09/27/2001	Ali Rihan	IN-5501	3634

26922 7590 03/04/2003

BASF CORPORATION
ANNE GERRY SABOURIN
26701 TELEGRAPH ROAD
SOUTHFIELD, MI 48034-2442

EXAMINER

ZALUKAEVA, TATYANA

ART UNIT	PAPER NUMBER
----------	--------------

1713

DATE MAILED: 03/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

A27

Office Action Summary

Application No.

09/965,423

Applicant(s)

RIHAN ET AL.

Examiner

Tatyana Zalukaeva, PhD

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1713

DETAILED ACTION

1. Claims 22-25 are added by Applicants' Amendment, paper No. 5.
2. Claims 1-25 are pending in the Application.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-21 stand and new claims 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Rink et al (U.S. 5,759,631).

Rink discloses **a refinish clear coating composition** comprising

(A) at least one hydroxyl group-containing polyacrylate resin obtained by polymerizing

(a) from **5 to 80% by weight of a cycloaliphatic ester** of methacrylic acid and/or acrylic acid, or a mixture of such monomers,

(b) from **10 to 50% by weight of a hydroxyl group-containing alkyl ester of methacrylic acid and/or acrylic acid, or mixtures of such monomers,**

(c) from 0 to 25% by weight of a **hydroxyl group-containing**, ethylenically unsaturated monomer, different from (a) and (b), or a mixture of such monomers, (reads on second hydroxy functional monomer)

(d) from 5 to 80% by weight of an aliphatic ester of methacrylic and/or acrylic acid, different from (a)-(c), or a mixture of such monomers,

(e) from 0 to 40% by weight of an aromatic vinyl hydrocarbon, different from (a)-(d), or a mixture of such monomers, and

Art Unit: 1713

(f) from 0 to 40% by weight of an additional ethylenically unsaturated monomer, different from (a)-(e), or a mixture of such monomers, and (B) at least one crosslinking agent. (see abstract).

The number average molecular weight is 1000 –5000 (column 2, lines 20-25). Weight average $M_w = M_n \times \text{polydispersity}$, which is said to be lower than 5 (column 2, line 23) , preferably from 1.8 to 4 (column 3, lines 16-20). Thus inherently $M_w = 5,000 \times 4 = 20,000$, which satisfies the limitations of claims 1 and 5. The hydroxyl number of a polymer is 60-180 mg of KOH/g, which meets the limitation of the instant claim 9.

Monomers (d) and (e) described in column 5, lines 25-43 meet the requirements of claim 10.

With specific regard to claims 18 and 19 Rink discloses that a coating composition employs crosslinking agent (B), which is selected from the group consisting of at least one **diisocyanate, polyisocyanate which contains isocyanurate** groups, and mixtures thereof. (see claim 11).

With regard to the process of coating Rink discloses the process summarized in claim 12, which is the process of the instant claim. The clear coating composition of Rink is designed for VOLVO.

Therefore all the limitations of the instant claims are either explicitly or inherently met by the disclosure of Rink.

5. Claims 1-21 stand and claims 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Rockrath et al (U.S. 5,716,678).

Rockrath discloses a clear coating composition and method of a production of two-coat finish on a substrate, a transparent lacquer composition containing a hydroxyl group-containing polyacrylate resin produced by polymerizing

(a) 10 to 51% by weight 4-hydroxy-n-butylacrylate or

4-hydroxy-n-butylmethacrylate or a mixture of 4-hydroxy-n-butylacrylate and 4-hydroxy-n-butylmethacrylate;

(b) 0 to 36% by weight of a hydroxyl group-containing ester of acrylic acid different from (a) or a hydroxyl group-containing ester of methacrylic acid or a mixture of such monomers;

(c) 28 to 85% by weight of an aliphatic or cycloaliphatic ester of

methacrylic acid different from (a) and (b) with at least 4 C atoms in the alcohol residue or a mixture of such monomers;

(d) 0 to 3% by weight of an ethylenically unsaturated carboxylic acid or a mixture of ethylenically unsaturated carboxylic acids and

(e) 0 to 20% by weight of an ethylenically unsaturated monomer different from (a), (b), (c) and (d) or a mixture

of such monomers, into a polyacrylate resin with a **hydroxyl number from 60 to 200** number average molecular weight from **1,500 to 10,000**.(abstract). Component (b) is described in column 4, lines 28-40. With regard to specific limitations of claim 5 that recites the weight average molecular weight, $M_w = M_n \times \text{polydispersity}$, it is a base presumption that the weight average molecular weight is within the claimed range,

Art Unit: 1713

since the polymers of Rockrath are essentially the same as instantly claimed and are made by essentially the same methods as those of the instant claims. It is also noted that the polydispersity of such polymers is usually larger than 2, which is evidenced above by Rink.

It is possible to employ a crosslinking compound (B), which are preferably derived from diisocyanates and contain isocyanurate groups (column 5, lines 49-56).

The process of refinishing substrate is disclosed in column 9, lines 40-53. Such steel panels coated with a commercial electro-deposition coating and a commercial filler are spray-coated with a commercial, nonaqueous basecoat which contains aluminum pigment, are dried for 5 minutes at room temperature and then are coated over with the transparent topcoats. After a further drying time of 5 minutes at room temperature, the basecoat and topcoat are baked together for 20 minutes at 140°C in a circulating-air oven. The resulting finishes are distinguished by a high degree of hardness, high gloss, good adhesion between basecoat and topcoat and good topcoat appearance.

With regard to the limitation of the instant claims of a viscosity expressed in Stokes it is a base presumption, that since the compositions of the instant claims and both Rockrath and Rink are identical and are made by essentially the same method, the properties even if not taught will be inherently the same. Products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore if the prior art teaches the identical chemical structure, the properties and characteristics applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705,709,15 USPQ2d 1655,1658 (Fed. Cir.

Art Unit: 1713

1990). Consult also *In re Fitzgerald*. In other words when the claimed compositions are not novel, they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in prior art.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-21 stand and claims 22-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application 09/886,742. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim clear coating composition comprising identical ingredients wherein the ranges of those components overlap with the ranges as instantly claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

6. Applicant's arguments filed December 17, 2002 have been fully considered but they are not persuasive. The crux of Applicants' arguments appears to hinge on the statement that Rink's reference "does not sufficiently describe the present invention to place the public in possession of it". Applicants further elaborate that the reference "... uses very broad ranges of its parameters that include ranges unsuitable for achieving the benefit of the present invention.... and does not disclose that certain parts of certain parts of its ranges of certain specific parameters must be combined...". This is not persuasive because Rink expressly discloses each and every limitation of the extremely broad instant claims 1-4, 6-25. The range claimed by Rink 5-80%, incorporates a very broadly claimed range at least 45%. As stated in MPEP 2131.03 a specific data point is defined as either end point of the range or a disclosed data point of the reference. It has long been held that the disclosure in the prior art of any range within, overlapping or touching the claimed range, anticipates when the prior art range discloses the claimed range with sufficient specificity. In the instant case a person skilled in the art would have clearly envisaged the claimed "at least 45%" from the disclosed 10-80% range as per Rink.

The Declaration under 37 CFR 1.132 filed December 17, 2002 is insufficient to overcome the rejection of claims 1-21 based upon Rink as set forth in the last Office action because:

Art Unit: 1713

a) the evidence of the secondary considerations, such as unexpected or superior results, as Applicants try to show in is irrelevant to 35 USC 102 rejections and cannot overcome a rejection so based, *In re Wiggins*, 488 F. 2d 538, 543, 179 USPQ 421, 425 (CCPA 1973), consult MPEP 2131.04.

b) the example in the Declaration utilizes a **single data point** within very broadly claimed range.

With regard to Rockhart reference, Applicants arguments reside in contention that Rockhart does not disclose a clearcoat composition containing an acrylic polymer. This is not found persuasive, because the passage in lines 11-15 of col. 2 states "... Two coat finish, in which in step 3 a nonaqueous **transparent** topcoat is applied. This coat is in details described in col.2, lines 15-35, discussed in the previous and present office actions, and does contain all acrylic comonomers in the ranges as instantly claimed.

With regard to the curing temperature, which Applicants allege to be in Rockhart 130-140°C, it is the Examiner's position that Rockhart discusses the temperature at which the top coat and the basecoat are baked together, not necessarily the curing temperature of acrylic resin. Furthermore, Applicants' arguments are more specific than the claims, because the curing temperature is not recited in the instant claims.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Resuming the above, Applicants are reminded that reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take this teaching in

Art Unit: 1713

combination with his own knowledge of the particular art and be in possession of the invention, as per *In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995), or *In re Sasse*, 207 USPQ 107 (CCPA 1980).

And furthermore, the disclosure in a reference must show the claimed elements arranged as in the claim, but need not be in identical words as used in the claim to be anticipatory. *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990).

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva, PhD whose telephone number is (703)30-8819. The examiner can normally be reached on 9:00 - 5:30.

Art Unit: 1713

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

TATYANA ZALUKAEVA
PATENT EXAMINER



February 26, 2003

Tatyana Zalukaeva, PhD
Primary Examiner
Art Unit 1713